



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q53565

Yoshihito ASAO

Appln. No.: 09/277,198

Group Art Unit: 2834

Confirmation No.: 3195

Examiner: K. Tamai

Filed: March 26, 1999

For: STATOR FOR AN AUTOMOTIVE ALTERNATOR AND METHOD OF
MANUFACTURE THEREFOR

REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellant respectfully submits
this Reply Brief in response to the Examiner's Answer dated August 15, 2003. Entry of this
Reply Brief is respectfully requested.

POINTS RAISED IN EXAMINER'S ANSWER

In the Brief on Appeal filed December 11, 2002, Appellant argued that Adachi in
combination with King does not disclose, teach or suggest a preformed stator coil with bridge
portions placed at least close to axial end surfaces of the stator core, as claimed, and one of

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ordinary skill in the art would not have been motivated to combine the references to produce the claimed invention.

In response to Appellant's arguments for patentability, the Examiner (page 6 of the Examiner's Answer) contends "[t]he Applicant's argument that King teaches away from preformed coils is not persuasive [because] King never states that the stator cannot be made with preformed coils ... [and] Adachi teaches that wave wound coils are individually wound and inserted into the core for easy manufacture." However, King's lack of disclosure regarding the use of either preformed coils or a prefinished core is important in the present context because, prior to the present invention, preformed stator coils, such as that disclosed by Adachi, could not be assembled to stator cores without significant gaps therebetween, without damage to the coils. (See page 5, lines 11-33 of Appellant's specification). While preformed coils in and of themselves, as well as individually wound coils with no gaps when assembled to a stator, might be argued to be known in the art, preformed coils without gaps, as claimed in Appellant's claim 1 are not known.

Moreover, the Examiner again has not address how one of ordinary skill in the art would have been able to modify Adachi in view of King to produce the claimed invention since, prior to the present invention, preformed stator coils could not be assembled to stator cores without significant gaps therebetween, without damage to the coils. Rather, the Examiner (page 7) simply asserts "King suggests that an axially compact, efficiently cooled motor is produced when the bridge portions are close to the stator." However, absent any evidence at all that the Examiner's combination of references could overcome, or even address this issue, there is no

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motivation to combine the two teachings, and, indeed, no indication whatever that the two references could be successfully combined, even if one were to attempt to do so. A proper §103 rejection requires both of these indicators, i.e., motivation to combine and a reasonable expectation of success. Accordingly, Appellant respectfully submits the King reference is not properly combinable with Adachi and even if so combined would not accomplish Appellant's claimed invention.

In view of the above, Appellant respectfully submits independent claim 1, as well as dependent claims 2-4, should be allowable because (1) the applied references, alone or in combination, do not teach or suggest all of the features of the claims, and (2) one of ordinary skill in the art would not have been motivated to combine and modify the teachings of the applied references in order to produce the claimed invention.

CONCLUSION

For the above reasons as well as the reasons set forth in Appellant's Brief on Appeal, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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CUSTOMER NUMBER

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